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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,081	01/07/2002	Jonathan D. Levine	D/A1202;690-010417-US (PA)	2426
7590 Clarence A. Green Perman & Green, LLP, 425 Post Road Fairfield, CT 06430			EXAMINER PAULA, CESAR B	
			ART UNIT 2178	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/20/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/041,081

Applicant(s)

LEVINE, JONATHAN D.

Examiner

CESAR B. PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the RCE amendment filed on 11/10/2006.

**This action is made Non-Final.**

2. In the amendment, claims 1-38 are pending in the case. Claims 1, and 20 are independent claims.

#### ***Drawings***

3. The drawings filed on 1/7/2002 have been approved by the examiner.

#### ***Claim Rejections - 35 USC § 112***

4. The rejection of claims 7, and 20 under 35 U.S.C. 112, second paragraph, has been withdrawn as necessitated by the amendment.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Claims 1 recites “*intermediate format, in a universal format, devoid of said digital structure and codes of an originating software, hardware, and operating system*” *lim.(b)*. The Examiner could not find this limitation in the disclosure, described in a manner as to allow one of ordinary skill in the art to perform it. There is no mention of missing digital structure and codes of an originating software or what this entails or encompasses. These are broad assertions not present in the disclosure of this invention.

7. Claim 20 also contains equivalent limitation to that of claim 1, and therefore is similarly rejected.

8. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *a universal format devoid of any particulars unique to the administrator of the system* (page 5, lines 11-12), does not reasonably provide enablement for “*intermediate format, in a universal format, devoid of said digital structure and codes of an originating software, hardware, and operating system*” *lim.(b)*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Examiner could not find in the specification the universal format which, is devoid of digital structure and codes of an originating software. There is no mention of missing digital structure and codes of an originating software or what this entails or encompasses. These are broad assertions not present in the disclosure of this invention.

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9. Claim 20 also contains equivalent limitation to that of claim 1, and therefore is similarly rejected.

10. Claims 1, and 20 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite “*in a universal format, devoid of said customized formatting and any particulars unique to an originator of said complete book file*” lines 8-10, and 10-12 respectively. It is still unclear what is meant by the language, since the book is customized by an originating author. The author specifies the content, layout, etc., to be included in the book. Therefore, it appears that the book would retain those characteristics specified by the originator regardless of what intermediate format the book is converted into. This would make the book not *devoid of said customized formatting and any particulars unique to an originator of said complete book file*. The Applicant submit that “A universal format, as referred to in this application is a digital file, in which the digital structure and codes of the originating software, hardware and operating system is absent(page 8). These components may be collectively referred to as the originating platform. In print-on-demand publishing, to which this application relates, the publishing process involves more than a collection of content, but also relates to the packaging and distribution of the content”. The Applicant is invited to introduce the language above to clarify the vague language of the claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3, 9-22, and 28-38 remain rejected under 35 U.S.C. 102(e) as being anticipated by Warmus et al, hereinafter Warmus (Pat.# 6,332,149 B1, 12/18/2001, filed on 2/11/1997).

Regarding independent claim 1, Warmus discloses the development of a template file representing pages of book(s) to be reproduced using data native to pc computer system, and using wordprocessing applications, such as Word®. The file contains fixed, and variable information indicating customized information to be inserted into the file—*receiving as a complete book file digital, including a book block, a digital representation with a digital structure and codes of an originating software, hardware, and operating system of a book targeted for reproduction--* (col.7, lines 59-col.8, line 7, col.1, line 58-col.2, line 6, and col. 10, lines 45-67).

Moreover, Warmus discloses converting the stripped template file into a PDL or PDF file (device independent, does not depend on the computer platform on which it is displayed or printed), which can be transmitted to a different computer system or— *converting said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of*

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*said digital structure and codes of an originating software, hardware, and operating system* (col. 10, lines 45-67, col.7, lines 34-54, col.11, lines 1-10). The file contains information specifying the positioning of fixed information—*storing said solution-independent, intermediate formatted book file along with book identification information*(generic or independent format with information identifying fixed positioning) *as a mastered book*.

Moreover, Warmus discloses premerging master PDL files with variable files before being provided to the printer —*converting said solution-independent, intermediate formatted book file to solution-dependent (premerged file) formatted book file* -- (col. 11, lines 47-51).

Furthermore, Warmus discloses using commands in a press file to create the finished books or book versions —*reproducing said book* -- (col. 11, lines 45-51).

Regarding claim 2, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced —*said book is in the form of electronic files* -- (col. 10, lines 45-67).

Regarding claim 3, which depends on claim 1, Warmus discloses scanning book pages into a system and printing them over a network —*scanning and converting scanned components into said digital representation* -- (col. 8, lines 8-30).

Regarding claim 9, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed —*generating hard copy book production information* -- (col.9, lines 12-44, col. 10, lines 45-67).

Regarding claim 10, which depends on claim 1, Warmus discloses using commands – *printing information* -- in a press file to create the finished books or book versions (col. 11, lines 45-51).

Regarding claim 11, which depends on claim 9, Warmus discloses creating the finished books or book versions in a “saddle-stitch” format – *binding information* -- (col. 9, lines 12-22).

Regarding claim 12, which depends on claim 1, Warmus discloses using a RIP processor for converting the book page files into bitmap page files – *creating a bitmap of the book block* -- (col. 8, lines 63-67).

Regarding claim 13, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files – *creating a bitmap of the book block* -- (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B).

Regarding claim 14, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed – *generating hard copy book production information* -- (col.9, lines 12-44, col. 10, lines 45-67).



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Regarding claim 15, which depends on claim 1, Warmus discloses using a format, having watermarks and barcode—*security information--*; for the book pages to be printed (col. 29, lines 22-35, col. 30, lines 6-12).

Regarding claim 16, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a CRT or LCD display —*book presentation information comprises viewing capabilities --* (col. 7, lines 24-42).

Regarding claim 17, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a printer — *book presentation information comprises printing capabilities --* (col. 7, lines 24-42).

Regarding claim 18, which depends on claim 1, Warmus discloses sending the book files to a remote location via the Internet —*providing access to said book via an electronic link --* (col. 7, lines 34-52).

Regarding claim 19, which depends on claim 1, Warmus discloses sending the book files, via email, to a remote location via a computer network —*delivering said book to a predefined destination --* (col. 7, lines 34-52).

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Claim 20 is directed towards a computer system for implementing the steps found in claim 1, with the exception of a *book reproduction workflows*—which is taught by the method for producing books that includes several conversion and other production steps-- *book reproduction workflows* --, as taught by Warmus (col.10, lines 45-col.11, line50, and therefore is similarly rejected.

Claims 21-22, and 28-38 are directed towards a computer system for implementing the steps found in claims 2-3, 9-13, 9, 15-19 respectively, and therefore are similarly rejected.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4-8, and 23-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Dickmeyer et al, hereinafter Dickmeyer (Pat. # 6,413,100 B1, 7/2/2002, filed on 8/8/2000).

Regarding claim 4, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification*

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*information comprises the book title.* However, Dickmeyer teaches providing the title of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 5, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book author.* However, Dickmeyer teaches providing the author of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 6, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publisher* However, Dickmeyer teaches providing the publisher of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and

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Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 7, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the International Standard Book Number*. However, Dickmeyer teaches providing the ISBN of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 8, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publishing date*. However, Dickmeyer teaches providing the copyright date of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3,

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lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Claims 23-27 are directed towards a computer system for implementing the steps found in claims 3-8 respectively, and therefore are similarly rejected.

### ***Response to Arguments***

15. Applicant's arguments filed 11/10/2006 have been fully considered but they are not persuasive. Regarding claim 1, the Applicants submit that Warmus fails to teach the solution-independent format devoid of *digital structure and codes of an originating software, hardware, and operating system* (pages 11-12). The Examiner disagrees, because Warmus discloses converting the stripped template file into a PDL or PDF file (device independent, does not depend on the computer platform on which it is displayed or printed), which can be transmitted to a different computer system where it can be displayed or printed— *converting said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of said digital structure and codes of an originating software, hardware, and operating system* (col. 10, lines 45-67, col.7, lines 34-54, col.11, lines 1-10). The file contains information specifying the positioning of fixed information—*storing said solution-independent, intermediate formatted book file along with book identification information*(generic or independent format with information identifying fixed positioning) *as a mastered book*.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "all of the

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pages are processed in the same manner, with respect to content", page 12, parag.2) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As far as can be ascertained, the claims do not recite the processing of all the pages in the same manner. Although, this is a broad assertion (since it's not clear what the same manner is), it is not part of the claimed language.

Claim 20 is rejected at least based on the same rationale submitted above.

### ***Conclusion***

- I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jeran et al. (Pat. # 6,842,740 B1 ), and Goldstein (Pat. # 6,281,893 B1).
- II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

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system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 or 571 272-1000 (USA or Canada).

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**CESAR PAULA**  
**PRIMARY EXAMINER**  
3/16/2007